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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,987	06/26/2003	Marc Christian Davis	DWP-1	5142
49578	7590	07/05/2006		
SIMMONS PATENTS P.O. BOX 1560 LENOIR, NC 28645			EXAMINER GRAHAM, MARK S	
			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,987

Applicant(s)

DAVIS ET AL.

Examiner

Mark S. Graham

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-21, 23-31 and 34-53 is/are pending in the application.
- 4a) Of the above claim(s) 26-31 and 34-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-21 and 23-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-8, 11-21, 23-31, 34-53 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

Art Unit: 3711

Newly submitted claims 34-53 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 1-8, 11-21, and 23-25 are drawn to a bat, classified in class 473, subclass 564.
- II. Claims 34-53 are drawn to a blank, classified in class 473, subclass 564.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as for making a different structural member such as a table leg and the inventions are deemed patentably distinct because there is nothing on this record to show them to be obvious variants.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Since applicant has previously elected and received an action on the merits for the originally presented invention of Group I, the bat, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-53 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Regarding RCE applications and restriction practice see MPEP § 818.02(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6, 7, 11, 13-16, 18, 19, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith. Note Bender at Col. 5, lines 16-19 specifically and the entire disclosure generally. Bender discloses the claimed device with the exception of the use of different first and second materials to obtain the different densities. However, such is a known technique in the art as taught by Smith. It would have been obvious to one of ordinary skill in the art to have used different materials in forming Bender's bat as well if it was desired to obtain particular densities in the different layers offered by different materials. With regard to the "sweet spot zone" or "center of mass" Bender's bat barrel will inherently have such a zone between two predefined points.

With regard to applicant's amendment to claim 13 requiring different lengths of the first and second portions note Bender at Col. 3, lines 40-48. The inner lamina portion extends the length of the bat and forms the handle and medial portion of the barrel while both outer lamina portions only extend the length of the barrel.

Applicant's first argument with regard to the prior art is that motivation to combine the Smith and Bender references is lacking. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the

prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one of ordinary skill in the art teaches that different densities may be obtained by using different materials. Provided with such knowledge it would have been obvious to one of ordinary skill in the art to have provided such an advantage to the Bender reference.

In response to applicant's further comments it is first noted that veneer is a plurality of layers of wood so Smith is completely applicable to the instant issue. What Smith teaches or does not teach about balance is irrelevant to the teaching that layers of different density may be obtained by using different materials.

Regarding the "predetermined" argument, when one manufactures a bat as disclosed by Bender one is inherently manufacturing a bat which has a predetermined "sweet spot zone" or "center of mass." This is all that the claims require. Bender's bat, just as applicant's, necessarily has its "sweet spot zone" or "center of mass" determined by the choices involved in selecting the lamina used in the bat. As with any bat a skilled user will prefer a bat of the Bender design to have particularly tailored properties deemed advantageous to that particular user.

With regard to claims 19 and 20, Bender does not specify the thickness of the lamina his outer (second and third) portions. However, he does disclose the inner lamina are of the claimed thickness and it would have been obvious to one of ordinary

skill in the art to have used the same thickness when constructing Bender's alternate embodiment bat to simply the step of cutting the lamina. This rejection is not based on hindsight but rather what Bender would suggest to the ordinarily skilled artisan constructing Bender's bat.

Concerning claims 11 and 24, both references teach the use of ash.

Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith and Cook. Bender in view of Smith obviates the claimed device for the reasons set forth above with the exception of the "apart" limitation. However, as disclosed by Cook it is known in the art to vary the density of the bat along the longitudinal axis of the bat by creating separate sections apart from one another. It would have been obvious to one of ordinary skill in the art to have done the same with Bender's laminated sections to tailor the bat to a particular batter's needs.

In response to applicant's argument that there is no suggestion to combine the Bender/Smith and Cook references, again the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cook teaches the advantages of using "apart" sections in a bat to vary the density along the longitudinal axis of the bat. One of ordinary skill in the art seeking to vary the density of the bat along the longitudinal axis of the bat would

Art Unit: 3711

obviously have seen the advantages of Cook's solution. Such a motivation is not hindsight but rather is what Cook itself teaches.

Claims 8 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith and Winterowd et al. (Winterowd). Bender in view of Smith obviates the claimed device with the exception of the type of bonding agent used. However, as disclosed by Winterowd bonding agents such as that claimed are known in the woodworking art for bonding laminates. It would have been obvious to one of ordinary skill in the art to have used such as Bender's bonding agent to provide a secure bond.

Claims 10, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith and Burns et al. (Burns). Bender in view of Smith obviates the claimed device with the exception of the sealant/protectant. However, as disclosed by Burns sealant/protectants such as that claimed are known for use on bats. It would have been obvious to one of ordinary skill in the art to have used such on Bender's bat to protect it.

Claims 12, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bender in view of Smith and You. Bender in view of Smith obviates the claimed device with the exception of the use of composites to form laminations. Bender uses wood for his laminations. However, as disclosed by You it is known in the art to use composites for such laminations as well. It would have been obvious to one of ordinary skill in the art to have used the same on Bender's bat to add strength to it.

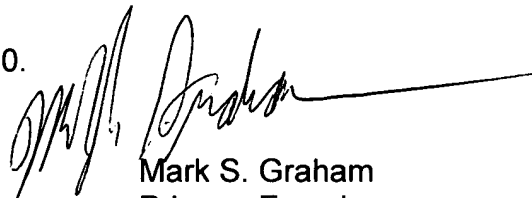
Applicant's arguments filed 11/16/05 with regard to claims have been fully considered but they are not persuasive.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG  
6/23/06



Mark S. Graham  
Primary Examiner  
Art Unit 3711